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| 10/740,749      | 12/22/2003  | Shinichi Mihara      | 009523-0306805      | 3391             |

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EXAMINER

RAIZEN, DEBORAH A

ART UNIT

PAPER NUMBER

2873

DATE MAILED: 03/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/740,749

Applicant(s)

MIHARA, SHINICHI

Examiner

Deborah A. Raizen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 4-7, 21-23, 29-34 and 36-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-7, 22, 23, 29-32, 36, 37 and 50 is/are allowed.
- 6) ☒ Claim(s) 48 and 49 is/are rejected.
- 7) ☒ Claim(s) 21, 33, 34, 38, 39, 45-47 and 51 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 10/741,000.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____.  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____.   | 6) <input type="checkbox"/> Other: ____.                                    |

## DETAILED ACTION

### *Specification*

The parent application, 10/741,000, has issued as patent number 6,687,059. Please include this number in the cross-reference to the parent.

### *Claim Objections*

1. Claims 21, 33, 34, 46, and 51 are objected to because of the following informalities:

In claims 21, 46, and 51, the definition of  $f_{31}$  as “a focal length of the concave lens element in the doublet component” lacks antecedent basis for “the concave lens element” and for “the doublet component”. It is also inconsistent with the definition on page 17, lines 18-20, of the specification. In claims 21, 46, and 51,  $f_{31}$  should be defined as it is in the specification to be: “the focal length of the cemented concave lens component in the third lens group”.

In claims 33 and 34, the definition of  $f_{31}$  is inconsistent with the definition in the specification. Please delete the words “element of a doublet” in the definition.

Appropriate correction is suggested.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 48 and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by Nakayama et al. (6,285,509, of record).

In regard to claim 48, Nakayama discloses a zoom lens system (Example 4, cols. 10-11, Fig. 4) comprising, in order from an object side thereof, a first lens group having negative refracting power (L1, Fig. 4), a second lens group having positive refracting power (L2), a third lens group having negative refracting power (L3), a fourth lens group having positive refracting power (L4) and a fifth lens group having positive refracting power (L5), wherein focusing on movement of an object point is carried out at the fifth lens group (col. 5, lines 61-63), and a plurality of axially fixed optical devices are located in the rear of the fifth lens group (DP, dichroic prism, and PI, display element), and

the third lens group comprises two lens components (Fig. 4) including a cemented lens component (having surfaces r16-r18) and a negative lens component (r14-r15), and the fourth lens group moves upon zooming from a wide-angle end to a telephoto end of the zoom lens system (arrow under L4 in Fig. 4).

In regard to claim 49, in the Nakayama zoom lens, upon zooming from the wide-angle end to the telephoto end of the zoom lens system, the fourth lens group moves so as to increase a space between the fourth lens group and an image plane (arrow under L4 is pointing away from the image plane).

*Response to Arguments*

4. Applicant's arguments, in REM, filed 12/10/2004, with respect to claims 21, 32, 34, 36, and 37 as currently amended in CLM 12/10/2004 have been fully considered and are persuasive. The rejection of claims 21, 32, 34, 36, and 37 has been withdrawn.

*Allowable Subject Matter*

5. Claims 4-7, 22, 23, 29-32, 36, 37, and 50 are allowed.

The following is an examiner's statement of reasons for allowance: The prior art taken either singularly or in combination fails to anticipate or fairly suggest the limitations of claims 4-7, 22, 23, 29-32, 36, 37, and 50, in such a manner that a rejection under 35 U.S.C. 102 or 103 would be proper.

In regard to claims 4-7, 22, 23, and 29-31, see the Office action of 09/10/2004.

The prior art fails to teach a combination of all the features in claim 32. For example, these features include the detailed structure and the condition recited, especially the limitation that the fourth lens group moves upon zooming, in combination with all the other limitations of the claim.

The prior art fails to teach a combination of all the features in claim 36. For example, these features include the detailed structure recited, especially the limitation that upon zooming from a wide-angle end to a telephoto end, the first lens group moves constantly toward an image side, in combination with all the other limitations of the claim. Claim 37 depends on claim 36 and is therefore allowed as well.

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The prior art fails to teach a combination of all the features in claim 50. For example, these features include the detailed structure recited, especially the limitation that the third lens group comprises, in order from the object side, a cemented concave lens component and a negative single lens component, in combination with all the other limitations of the claim.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

6. Claims 21, 33, 34, 38, 39, 45-47, and 51 are objected to as having informalities or depending on a claim that has informalities, but would be allowable if the informalities were corrected.

The following is a statement of reasons for the indication of allowable subject matter: The prior art taken either singularly or in combination fails to anticipate or fairly suggest the limitations of claims 21, 33, 34, 38, 39, 45-47, and 51, in such a manner that a rejection under 35 U.S.C. 102 or 103 would be proper.

In regard to claim 33, see the Office action of 09/10/2004.

Claims 38, 39, 45, and 47 depend only on claims that are allowed or have allowable subject matter, and, therefore, claims 38, 39, 45, and 47 have allowable subject matter as well.

The prior art fails to teach a combination of all the features in claim 21. For example, these features include the detailed structure and the condition recited, especially the limitation

that the fourth lens group moves upon zooming, in combination with all the other limitations of the claim.

The prior art fails to teach a combination of all the features in claim 34. For example, these features include the detailed structure and the conditions recited, especially the limitation that the fourth lens group moves upon zooming, in combination with all the other limitations of the claim.

The prior art fails to teach a combination of all the features in claim 46. For example, these features include the detailed structure and the condition recited, especially the limitation that the first lens group moves upon zooming, in combination with all the other limitations of the claim.

The prior art fails to teach a combination of all the features in claim 51. For example, these features include the detailed structure and the condition recited, especially the limitation that the third lens group comprises, in order from the object side, a cemented concave lens component and a negative single lens component, in combination with all the other limitations of the claim.

### *Conclusion*

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah A. Raizen, Ph.D., J.D., whose telephone number is (571) 272-2336. The examiner can normally be reached on Monday-Friday, from 10:00 a.m. to 3:00 p.m. Eastern Standard Time (a part-time schedule).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (571) 272-2328. The USPTO central official fax number is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. For more information, see <http://pair-direct.uspto.gov>. For access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or at 703-305-3028 or at 703-308-6845, or by e-mail at: [ebc@uspto.gov](mailto:ebc@uspto.gov). Additional information is available on the Patent EBC Web site at: <http://www.uspto.gov/ebc/index.html>.

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Scott J. Sugarman  
Primary Examiner